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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,704	05/25/2006	Tatsuo Nakajima	17214/012001	5340

22511 7590 06/16/2008
OSHA LIANG L.L.P.
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

EXAMINER

CHARLES, MARCUS

ART UNIT	PAPER NUMBER
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3682

NOTIFICATION DATE	DELIVERY MODE
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06/16/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
buta@oshaliang.com

Office Action Summary	Application No. 10/580,704	Applicant(s) NAKAJIMA ET AL.	
	Examiner Marcus Charles	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-25-2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the first action relating to serial application number 10/580,704 filed 5-25-2006.

Claims 1-7 are currently pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The examiner has accepted the drawing filed with this application as formal drawing.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 5-7, the intended scope of the claim are unclear because the claims recites, An IC tagged sealing member, a core metal, an IC tag, an elastic element etc. These limitations are recited in claim 1. Therefore, it is not clear if the elements of claim 1 and claim 5 are the same. If they are the same, then there includes a double inclusion.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Binder (6,002,248). Binder discloses an IC tagged bearing device comprising a chip (6) embedded in an elastic bearing seal (5), that is delimited between the inner race and the outer race, wherein the IC chip (6) comprising a storing means (22) that is capable of performing communication on a non-contact basis. In addition, it is apparent the sealing (5) includes a metal core for preventing the collapse of the sealing material during operation.

In claim 2, note the elastic (5) material is made from rubber and the chip is fixedly bonded by vulcanization to the elastic element (see col. 5, lines 50-64).

In claims 5-6, Binder discloses the claimed invention above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binder in view of Rehfus et al. (6,501,382). Binder fails to disclose the sealing

member is provided with a groove for accommodating the IC tag. Rehfus et al. discloses a bearing (12) comprising a bearing member (5) which may be metal or rubber, the bearing member has a groove (21) that accommodates an IC tag (28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the elastic element and core metal of Binder so that each includes a groove in view of Rehfus et al. in order to attach or remove the chip without damaging the bearing member or the chip.

9. Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binder in view of Nachtigal et al. (6, 559,633). Binder fails to disclose the sealing member is provided with a groove for accommodating the IC tag. Nachtigal et al. discloses a bearing (100) comprising a bearing sealing member comprising a core metal (24) and an elastic member (50), each of the core metal and the elastic element has a groove that accommodates a sensor chip (30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sealing member of Binder so that both the core metal and the elastic has a fitting groove and a position hole in view of Nachtigal et al. in order to prevent inadvertent movement of the chip due to vibration and rotation effect.

Citation

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the prior art cited in attached PTO Form 892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (571) 272-7101. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ridley Richard can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus Charles
/Marcus Charles/
Primary Examiner, Art Unit 3682